

17 JUL 2007



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SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Suite 800
Washington, DC 20037

In re Application of :
SHIMIZU, Kenji *et al* :
U.S. Application No.: 10/541,905 :
PCT No.: PCT/JP04/00205 :
Int. Filing Date: 14 January 2004 :
Priority Date: 14 January 2003 :
Attorney Docket No.: Q73847 :
For: MAGNETIC RECORDING MEDIUM, :
METHOD OF MANUFACTURING :
THEREOF, AND MAGNETIC :
READ/WRITE APPARATUS :

DECISION

This decision is in response to the "Petition Under 37 CFR § 1.181 to Withdraw A Holding of Abandonment, and . . ." filed on 18 January 2007 and the petition under 37 CFR 1.47(a) originally filed 17 May 2006.

BACKGROUND

On 17 February 2006, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a \$130.00 surcharge fee was required. A two-month time limit in which to respond was set with extensions of time available.

On 17 May 2006, applicants purportedly filed a response which contained, *inter alia*, a petition under 37 CFR 1.47; an executed declaration; a "Statement of Facts" by Masaaki Yanagisawa; Documents 1 - 7; an assignment and fee; a \$130.00 petition fee; a \$130.00 surcharge fee; a one-month extension and \$120.00 fee; and authorization to the charge any additional fee as required to Deposit Account No. 19-4880. These documents were not located in the application.

On 19 December 2006, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) stating that the above-captioned application was abandoned because applicants failed to respond to the Form PCT/DO/EO/905 mailed 25 August 2004 within the time period set.

On 18 January 2007, applicants filed a petition to withdraw the holding of abandonment which was accompanied by, *inter alia*, copies of the documents

purportedly filed 17 May 2006 and a date-stamped postcard receipt for the 17 May 2006 documents.

DISCUSSION

Petition to Withdraw the Holding of Abandonment

A review of the subject application shows that the 17 May 2006 response purportedly filed in the above-captioned application was not located in the file. Nonetheless, the fees as described above were located in the application as submitted on 17 May 2006.

A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

In this case, applicants have provided a copy of the date-stamped postcard receipt for documents submitted 17 May 2006. The postcard receipt records that among the papers received in the USPTO included a "Petition Under 37 C.F.R. § 1.47(a)." The postcard receipt is stamped "OIPE IAP45 MAY 17 2006" across its face. The U.S. application number, docket number and name of the applicants are all listed on the postcard receipt.

Accordingly, applicants have provided *prima facie* evidence that a proper response to the Form PCT/DO/EO/905 mailed 17 February 2006 was received by the USPTO on 17 May 2006.

DECISION

For the reasons discussed above, applicants' petition to withdraw the holding of abandonment is **GRANTED**.

The Form PCT/DO/EO/909 mailed 19 December 2006 is hereby **VACATED**.

Petition Under 37 CFR 1.47(a)

In the response submitted 17 May 2006, applicants claim that they have been unable to locate one of the inventors, Mr. Nguyen Tien Duong, and filed a petition under 37 CFR 1.47(a) in response to the Form PCT/DO/EO/905 mailed 19 December 2006.

DISCUSSION

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a

statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventors. Applicants completed items (1) and (3) with this petition.

Concerning item (1), the fee for a petition under 37 CFR 1.47 changed to \$200.00 on 08 December 2004. Petitioners submitted a \$130.00 petition fee on 28 June 2005. The \$70.00 difference will be charged to Deposit Account No. 19-4880 as authorized. Item (1) of 37 CFR 1.47(a) is complete

Regarding item (2) of 37 CFR 1.47(a), section 409.03(d) of the MPEP discusses situations where an inventor cannot be reached and states, in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made . . .

The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, applicants submitted a statement of facts by Mr. Yanagisawa dated 26 April 2006. Mr. Yanagisawa indicates that a copy of the application and request for signature were sent to Mr. Duong at his latest address in Vietnam on 12 July 2005. However, Mr. Yanagisawa has been unable to verify whether the nonsigning inventor received these documents as no request was made to the Post office within six months of mailing as required by their rules. Mr. Yanagisawa then conducted an internet search for Mr. Duong in Vietnam to no avail. Finally, Mr. Yanagisawa claims that the documents were again sent to Mr. Duong on 03 February 2006. A copy of the FedEx International Air Way Bill was submitted which shows that the documents "were received by someone." However, the 37 CFR 1.47(a) applicants have not yet received a reply and could not determine who actually received the documents. The statement of facts was dated 26 April 2006. A review of the FedEx Track Shipments document provided verifies that the documents were "DELIVERED" on 07 February 2006.

This evidence is sufficient to show that a "diligent effort" was made to locate the nonsigning inventor. Item (2) of 37 CFR 1.47(a) is satisfied.

A copy of the last known address for Mr. Huong in Vietnam was submitted as:

10/541,905

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Mr. Nguyen Tien Duong
Phong 508,
Day nna No. 1A
Ban dao Linh Dam
Quan Hoong Mai
Hanoi, Vietnam

As such, item (3) is satisfied.

Concerning item (4), the 37 CFR 1.47(a) applicants submitted a declaration signed by eight of the nine co-inventors on behalf of themselves and the nonsigning joint inventor. The residence, mailing address and citizenship of all nine inventors are recorded on the declaration as required. The declaration includes statement that the English text is an accurate translation of the foreign text pursuant to 37 CFR 1.69. This satisfies item (4) of 37 CFR 1.47(a).

DECISION

Applicants' petition under 37 CFR 1.47(a) is **GRANTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 14 January 2004 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 17 May 2006.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record and will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.



James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302



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Dear Mr. Duong:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. The counsel for the applicant is listed below. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.



James Thomson
Attorney Advisor
Office of PCT Legal Administration

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